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TOTAL Number of Pages in This Submission

Application Number	10/815,468
Filing Date	March 31, 2004
First Named Inventor	Lam, Kit S.
Art Unit	1641
Examiner Name	Melanie J. Yu
Attorney Docket Number	02307W-131410US

FFW

## ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
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<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard; Response to Restriction/Election Requirement
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	Remarks The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.	

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

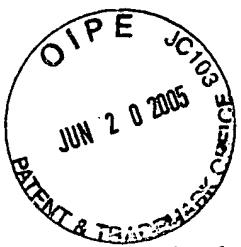
Firm Name	Townsend and Townsend and Crew LLP		
Signature			
Printed name	Mark H. Hopkins		
Date	June 17, 2005	Reg. No.	44,775

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Signature	
Typed or printed name	Karen Karlin
Date	June 17, 2005

**PATENT**  
Attorney Docket No.: 02307W-  
131410US  
Client Ref. No.: 2003-170-2



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/815,468  
Applicant : Kit S. Lam  
Filed : March 31, 2004  
TC/AU : 1641  
Examiner : Melanie J. Yu  
Docket No. : 02307W-131410US  
Customer No. : 20350

Confirmation No. 6380

**RESPONSE TO  
RESTRICTION/ELECTION  
REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

In response to the Restriction Requirement mailed May 17, 2005, please enter the following remarks. Claims 1-28 are pending in the application and subject to a restriction requirement. The Examiner has requested restriction to one of the following inventions (Groups I-IV):

- I. Claims 1-13, drawn to a microarray, classified in class 422, subclass 82.07.
- II. Claims 14-21, drawn to methods of use, classified in class 435, subclass 287.2.
- III. Claims 22-26, drawn to methods of promoting cell or tissue growth, classified in class 435, subclass 41.
- IV. Claims 27-28, drawn to methods of assaying the binding of ligands, classified in class 435, subclass 4.

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Reply to Office Action dated May 17, 2005

Applicants elect to prosecute the invention of Group I (claims 1-13, drawn to microarrays). The Examiner has also requested Applicants to elect a single disclosed species. In response, Applicants elect the invention wherein the biopolymer is an oligosaccharide attached to a glass support by hydrogen bonding. Applicants reserve the right to rejoin method claims and file a divisional or related application to the claims of the non-elected Groups.

Moreover, Applicants election is made with traverse. The Office alleges that Groups I and II represent distinct inventions, though related as product and process of making the product. The Examiner alleges that the inventions are distinct as the product can be made by a materially different process (MPEP §806.05(f)). In addition, the Office alleges that Groups I, III and IV represent distinct inventions, though related as product and process of use. The Examiner alleges that the inventions are distinct as the product can be used in another materially different process (MPEP §806.05(h)).

Under 35 U.S.C. § 121, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) the inventions must be independent or distinct as claimed; and
- (2) there must be a serious burden on the examiner if restriction is not required (emphasis added). *See MPEP § 803.* Applicants submit that both these criteria are not met by the presently claimed invention.

The claims of Groups I-IV encompass a single inventive concept. Specifically, the present invention provides compositions and methods of making and using the compositions. Accordingly, Applicants believe that any search for the compositions of the invention will provide materials relating to methods using the compositions. The Patent Office even notes that all of the method claims belong to the same class. Thus, Applicants believe that prosecution of the invention, as a whole, would not place a serious burden on the Office sufficient to justify restrictions.

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## CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for substantive review on their merits. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5014.

Respectfully submitted,



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Reg. No. 44,775

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